

UNITED STATES JUDICIAL PANEL
on
MULTIDISTRICT LITIGATION

**IN RE: PAPST LICENSING DIGITAL
CAMERA PATENT LITIGATION**

MDL No. 1880

ORDER VACATING CONDITIONAL TRANSFER ORDER

Before the Panel:* Accused infringer Hewlett-Packard Co. (HP) moves under Panel Rule 7.1 to vacate the Panel's order conditionally transferring the two actions listed on the attached Schedule A to MDL No. 1880. No party responded in support of transfer, though patent holder Papst Licensing GmbH & Co. KG (Papst) noted, in withdrawing its own motion to vacate, that it does not oppose transfer.

After considering the argument of counsel, we find that while these actions involve some common questions of fact with the actions previously transferred to MDL No. 1880, transfer will not necessarily serve the convenience of the parties and witnesses or promote the just and efficient conduct of the litigation. We initially centralized this litigation involving actions that shared factual questions arising from Papst's claims that digital cameras made by certain manufacturers infringe two of its patents, the validity and enforceability of which were at issue in all five actions. *See In re: Papst Licensing Digital Camera Patent Litig.*, 528 F. Supp. 2d 1357 (J.P.M.L. 2007). Papst's two patents, United States Patent Nos. 6,470,399 and 6,895,449, were invented by Michael Tasler and relate, broadly, to an interface device for communication between a host device and another device from which data is to be acquired. Many, but not all, of the devices that Papst contends infringe these patents are digital cameras; other devices included audio voice recorders, camcorders and video cameras. Recently, we transferred six actions involving two relatively new Tasler patents – U.S. Patent Nos. 8,504,746 and 8,966,144 – brought against many of the parties already subject to the MDL No. 1880 proceedings; in fact, many of the same products or product lines were involved in those new cases. *See In re: Papst*, Transfer Order, doc. 93 (J.P.M.L., October 13, 2015).

The actions before us now involve the alleged infringement of the two new Tasler patents by HP tablet computers, products not involved in the MDL No. 1880 proceedings. The addition of these products (stand alone computers) to the MDL will implicate different prior art than the actions already involved in the MDL (which involves peripheral devices). Transfer may spawn a host of different arguments related to infringement, which could hinder the efficient resolution of this litigation. A separate development effort reportedly led to introduction of the HP tablet computers now accused of infringement—HP's commercial mobility group and consumer mobility group were reportedly responsible for the development of the accused tablets. As a result, HP argues that it will be calling

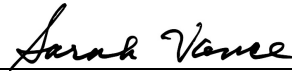
* Judges Majorie O. Rendell and Lewis A. Kaplan did not participate in the decision of this matter.

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different witnesses on non-infringement and damages than it would have in the MDL proceeding and that discovery from HP in the two proceedings will not substantially overlap. Moreover, as evidenced in the parties' September 2, 2015, case management statement filed in the Northern District of California action, the parties have agreed that all documents produced by the parties in MDL No. 1880 will be treated as if it were produced in that action. This agreement helps reduce the risk of duplicative discovery. Should the need arise, we encourage the parties to employ other available alternatives to transfer to minimize the potential for duplicative discovery and inconsistent pretrial rulings. *See, e.g., In re: Eli Lilly & Co. (Cephalexin Monohydrate) Patent Litig.*, 446 F. Supp. 242, 244 (J.P.M.L. 1978); *see also* Manual for Complex Litigation, Fourth, § 20.14 (2004).

IT IS THEREFORE ORDERED that the Panel's conditional transfer order designated as "CTO-7" is vacated.

PANEL ON MULTIDISTRICT LITIGATION

A handwritten signature in cursive script, reading "Sarah S. Vance", is positioned above a horizontal line.

Sarah S. Vance
Chair

Charles R. Breyer
R. David Proctor

Ellen Segal Huvelle
Catherine D. Perry

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SCHEDULE A

Northern District of California

HEWLETT-PACKARD COMPANY v. PAPST LICENSING GMBH & CO. KG,
C.A. No. 3:15-2101

District of Delaware

PAPST LICENSING GMBH & CO. KG v. HEWLETT-PACKARD COMPANY,
C.A. No. 1:15-497